

REMARKS

Reconsideration and allowance of the subject application are respectfully requested. By this Amendment, Applicant has amended claims 1-5 and 7-11 and added new claims 13-15. Accordingly, upon entry of this Amendment, claims 1-15 are all the claims pending in the application. In response to the Office Action, Applicant respectfully submits that the claims define patentable subject matter.

I. Overview of Office Action

Claim 12 is rejected under 35 U.S.C. § 101 as allegedly directed to non-statutory subject matter. Claims 1, 3-10 and 12 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Tsuchino (U.S. Patent No. 5,260,573) in view of Statius Muller (U.S. Patent Application Publication No. 2001/0032101). Claims 2 and 11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Tsuchino in view of Statius Muller and further in view of Deguchi et al. (U.S. Patent No. 6,133,984, hereafter "Deguchi").

II. Preliminary Matters

A. Foreign Priority

Applicant thanks the Examiner for acknowledging Applicant's claim for Foreign Priority, and confirming receipt of a certified copy of the priority document in the United States Patent and Trademark Office.

B. Information Disclosure Statement

Applicant thanks the Examiner for initialing and returning a copy of the PTO/SB/08 submitted with the Information Disclosure Statement filed on June 26, 2003.

III. Objections to the Specification

The Examiner alleges that the title of the invention is not descriptive. By this Amendment, Applicant has amended the title of the invention in order to improve clarity.

The Examiner also objects to the specification because of various informalities. By this Amendment, Applicant has amended the specification in order to improve clarity. Accordingly, the Examiner is respectfully requested to remove the objections to the specification.

IV. Rejection under 35 U.S.C. § 101

Claim 12 stands rejected under 35 USC §101 because it is allegedly directed to non-statutory subject matter. The Examiner argues that:

If in claim 12 the Applicant is attempting to claim the image recording medium as being the material produced by the method of recording recited in claim 1 respectively, claim 12 is rejected under 35 USC 101 because the claimed invention is directed to non-statutory subject matter. This claim does not fall within an enumerated statutory category; does not cover a 101 judicial exception or a practical application... This claim recites only nonfunctional descriptive material and therefore is nonstatutory.¹

However, Applicant respectfully disagrees with the Examiner's position, and submits that the statutory requirements of 35 U.S.C. § 101 have been met for at least the following reasons.

First, it is well established that in order to satisfy the requirements of 35 U.S.C. § 101, a claimed invention must produce a "useful, concrete and tangible result," *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601-02. In the instant application, an image recording medium is used for recording a visual image in one area of the medium and an image pertaining to attributes of the

¹ Pages 2-3 of the Office Action dated March 26, 2007.

image recording medium or recording apparatus in another area of the medium. The recording of the two distinct images in distinct areas of the medium is a “tangible result” of the claimed invention.

Further, the “usefulness” of the claimed invention is established by its ability to allow an operator to easily discern attributes of the recording medium or the recording apparatus if recording problems occur. Accordingly, Applicant respectfully submits that the 35 U.S.C. § 101 rejection is erroneous, and requests that the Examiner remove this rejection.

Second, Applicant agrees with the Examiner’s assertion that claim 12 does not cover a judicial exemption (an abstract idea, law of nature or natural phenomenon). The Interim Guidelines on Patent Eligible Subject Matter (MPEP 2106) state that “any new and useful process, machine, manufacture or composition of matter under the sun that is made by man is the proper subject matter of a patent.” The Guidelines note that the courts have developed three exceptions to these statutory categories of patentable subject matter. These exceptions are limited to abstract ideas, laws of nature, and natural phenomena. Applicant respectfully submits that using a recording medium to record visible images in addition to attributes of the recording medium or the recording apparatus, is not an abstract idea, law of nature, or natural phenomenon. Instead, this is a new and useful process, in which an operator can easily analyze recording errors. Therefore, claim 12 is directed to statutory subject matter under 35 U.S.C. § 101.

Third, even if claim 12 falls within a judicial exemption, it would be directed to a practical application of a judicial exemption, and therefore would constitute patentable subject matter under 35 U.S.C. § 101, since, as noted in the Guidelines, if a claimed invention falls within a judicial exemption, it is nonetheless directed to statutory subject matter if it is directed to a practical application of that judicial exception. In particular, a claimed invention is directed

to a practical application if it transforms an article or physical object to a different state or thing, or otherwise produces a useful, concrete, and tangible result. The Guidelines state that the tangible result requirement only requires that a “process claim must set forth a practical application of that judicial exception to produce a real-world result.” The Guidelines further state that a patent is granted for “the discovery or invention of some practical method or means of producing a beneficial result or effect.” As discussed above, the recording of visible images in addition to attributes of the recording medium or the recording apparatus is a “tangible result” of the claimed invention

Accordingly, for at least these reasons, Applicant respectfully submits that the Examiner has failed to establish a prima facie case of unpatentability under 35 U.S.C. § 101, and requests that the rejection of claim 12 under 35 U.S.C. § 101 be reconsidered and withdrawn.

V. Prior Art Rejections

Disclosure of Tsuchino

Tsuchino generally discloses a radiographical recording and reading apparatus (FIG. 2), wherein an X-ray apparatus 2 irradiates X-rays towards an object 4, a phosphor plate 5 accumulates and stores energy according to the distribution of radiation transmitted through the object 4. An excitation light beam scans the phosphor plate 5, and the scanned image is converted by a converting unit 7 to incident light. The disclosed system clearly relates to recording of a latent image. The converted signals are sent to an image processing unit 9, where it is converted to a digital image and sent to an image reproducing unit 10. The clarity of the digitized image will be affected by multiple characteristics including the unevenness of the recording generator and the unevenness in the distributed phosphor in the recording medium. The digitized image, derived from latent images, must be compensated. To this end, magnetic

tape 21 is arranged on a portion of the phosphor plate 5, and is used for storing sensitivity information of every phosphor plate 5 (column 5, lines 43-51) and also the recording apparatus, so that irregularities can be corrected.

Disclosure of Statius Muller

Statius Muller generally discloses a management system for the management of medical data. Data stored in a workstation 4 is assigned to individual data sets (8-11), and a code generating means 6 generates identification codes to be assigned to the individual data set elements (paragraph [0014]). Digital data set elements (81-85) are assigned identification codes which are displayed together with the data set elements (paragraph [0014]).

Analysis

The Examiner alleges that Tsuchino discloses all of the features of independent claim 1 and analogous independent claims 7 and 12 except for the feature “recording image data as a visible image on an image recording medium” as recited in claim 1 and analogously recited in claims 7 and 12. The Examiner thus relies on Statius Muller to cure this conceded deficiency. Applicant respectfully submits that claims 1, 7, and 12 would not have been rendered obvious in view of the cited references.

In the present case the Examiner has not provided any supportable objective reasoning why one of ordinary skill in the art would have been motivated to modify Tsuchino in view of Statius Muller. The Examiner contends it would be obvious to record the visible image of Statius Muller into the device of Tsuchino to allow the user to view information about the medium. This rationale is flawed for at least three reasons.

First, claim 1 describes recording a visible image onto a recording medium. This visible image is recorded in addition to the attribute information. The Examiner relies on contents of the

magnetic tape 21 (Tsuchino) as holding attribute information. However, this information (in magnetic readable form) does not allow the user to view the information on the medium with any particular ease. The user would still need a separate device to read the information, thereby undermining the Examiner's basis for the combination.

Further, the "attributes" of the image recording medium itself as depicted in the instant application is not necessarily identification information as disclosed in the cited references. They may be attributes of the image recording medium itself, for example, the terms of validity of the image recording medium and the types thereof.

The cited references are similar to the related art mentioned on page 2, line 17 to page 3, line 13 of the original specification. In the instant invention, attributes of the image recording medium itself, for example, the terms of validity of the image recording medium, are recorded on the image recording medium, instead of the identification information as disclosed in the cited references. Therefore, in the instant invention, it is possible to clearly recognize the situation or condition in which an image has been recorded on an image recording medium. this is contrary to the teachings of the cited references.

Second, the Examiner's stated rationale appears to be erroneous due to a misreading of the independent claim. Claims 1 does not necessitate that the attribute information be visible, but describes that the image is visible. Thus, the Examiner's stated rationale for the combination is clearly erroneous.

Third, one skilled in the art would not combine a visible image of Statius Muller with the latent image recording method of Tsuchino. The reason Tsuchino requires compensation upon digitization of the stored image stems from the fact that the image of Tsuchino is latent. Thus, defects within the phosphor recording medium and those produced by the recording generator

must be corrected. If the image were visibly recorded, such errors could be corrected without separate designation of the defects attributable to particular media or devices. In other words, to make the image of Tsuchino visible would obviate the need to provide separately, the attribute information. Thus the references teach away from their combination with each other.

Moreover, the Examiner does not address how one of ordinary skill in the art would have been able to modify Tsuchino in view of Muller to produce the claimed invention since the Tsuchino system is based upon the storing of information pertaining to the sensitivity of a phosphor plate in an area of the phosphor plate, while Statius Muller relates to the printing of identification codes associated with data sets along with an image of the data sets on a recording medium. The references are directed to completely different objects such that there is no reason to combine or modify their teachings in view of each other.

For this reason, Applicant respectfully submits that the Examiner's §103 rejection of claim 1 is improper.

Applicant respectfully submits that it is quite clear that none of the cited references teach or suggest the features of claim 2 and analogous claim 11. In particular, there is no teaching or suggestion in the cited references that the "image recording medium is removed from a package of a plurality of image recording mediums, and the image data is recorded as the visible image on the removed image recording medium, and wherein said information including the attributes of the image recording medium comprises information indicated on at least said package", as recited in claim 2 and analogously recited in claim 11. The Examiner cites column 5, lines 12-17 of Deguchi as allegedly disclosing these features of the claims. However, these cited portions of Deguchi merely disclose that when photographic paper is loaded into a magazine, the magazine is set on a channel that matches the paper. Bar codes provided on the outer bag of the

photographic paper are read so that information of the type and size of paper may be stored in a memory. Nowhere does this cited portion (or any other portion) of Deguchi teach or suggest that the recording medium is removed from a package of recording mediums, and the information including the attributes of the image recording medium comprises information indicated on the package as required by the claims.

Accordingly, Applicant respectfully submits that claims 1, 7, and 12 should be allowable because the cited references alone or in combination, do not teach or suggest all of the features of the claims, and one skilled in the art would not be motivated to modify or combine the references to produce the claimed invention. Claims 2-6, 8-11 and 13-15 should also be allowable at least by virtue of their dependency on independent claims 1, 7, and 12.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

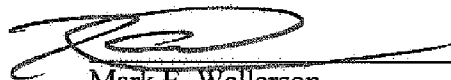
SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Respectfully submitted,



Mark E. Wallerson
Registration No. 59,043

Date: June 26, 2007